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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/806,761      | 03/23/2004  | Inka Henze           | 2719A               | 2427             |

7590 02/04/2005  
STRIKER, STRIKER & STENBY  
103 East Neck Road  
Huntington, NY 11743

EXAMINER

STEIN, STEPHEN J

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1775

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,761

Applicant(s)

HENZE ET AL.

Examiner

Stephen J Stein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/17/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of copending Application No. 10/635,950. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. While it is noted that the claims of the '761 application use the preamble article and the claims of the instant application use the words apparatus, the words are interpreted as being completely synonymous since there is nothing in the claims to distinguish them.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 3 recites the limitation "wherein said surface coating is provided

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on a surface of said supporting substrate to be coated after activation of said surface of said supporting substrate to be coated and/or after applying at least one or more suitable adhesives to said surface of said supporting substrate to be coated". This limitation is unclear to the examiner. The limitation "to be coated after activation of said surface of said supporting substrate to be coated" makes the claim indefinite because it is unclear what is meant by the second phrase "to be coated". Clarification is requested.

6. Claim 9 recites the limitation "further comprising an additional protective layer for said surface coating and wherein said additional protective layer comprises an enamel and/or decorative or functional printing with ceramic or organic decorative paint". This limitation makes the claims indefinite because the claim improperly claims in the alternative. Consequently the scope of the claim is unclear.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 6-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,424,130 (Nakashani et al.)

Nakashani teaches a water repellent glass sheet (a component for a cooking appliance or glass baking sheet) made of a glass substrate and water repellent film comprised of SiO<sub>2</sub> and a fluoroalkyl silane (inconspicuous hydrophobic coating) (See abstract and col. 6). Nakashani further teaches that the water contact angle is 110° (See Table 1) and has a thickness of 0 –

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100nm (Claim 11). With regard to the claimed heat resistant temperatures, it is expected that the disclosed water repellent film will exhibit this property since it is the same composition as claimed by applicants. With regard to the process limitations recited in the claims, process limitations in product claims are generally not dispositive on patentability unless it is shown that the process limitations produce a materially different product. MPEP §2113.

9. Claims 1-8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5624625 (Takahashi et al.).

Takahashi teaches a multilayer water glass repellent film formed on a glass substrate (a component for a cooking appliance or glass baking sheet) comprised of a fluoroalkylsilane and tin oxide particles (See abstract). Takahashi further that the water repellent film has water contact angle of 100° and greater (See Tables 1 and 2) and a thickness of 50nm. The reference further teaches that the tin oxide particles have a particle size of about 5nm (nanometer sized particles) (See example 25). With regard to the claimed heat resistant temperatures, it is expected that the disclosed water repellent film will exhibit this property since it is the same composition as claimed by applicants. With regard to the process limitations recited in the claims, process limitations in product claims are generally not dispositive on patentability unless it is shown that the process limitations produce a materially different product. MPEP §2113.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Stein whose telephone number is 572-272-1544. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If the

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attempts to reach the examiner are unsuccessful, the examiner's supervisor, Deborah Jones can be reached by dialing 571-272-1535. The official fax number is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 1, 2005



Stephen J. Stein  
Primary Examiner  
Art Unit 1775